

REMARKS/ARGUMENTS

Claims 1-11 and 13-33 are pending.

Claims 14-21 are withdrawn from consideration.

Claims 1-11, 13 and 22-33 are rejected.

Claims 1 and 22 have been amended. Support for these amendments can be found throughout the specification and drawings, as originally filed.

35 USC §102(e) REJECTION

Claims 1-5, 9-11 and 13 are rejected under 35 USC §102(e) as being anticipated by U.S. Patent No. 6,584,950 to Cunningham.

The Applicants respectfully traverse the 35 USC §102(e) rejection of claims 1-5, 9-11 and 13.

The law is clear that anticipation, under 35 U.S.C. §102(e), requires that the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

The law is also clear that a claim in dependent form shall be construed to incorporate all the limitations of the claim to which it refers. 35 U.S.C. §112 ¶ 4.

In the interests of expediting the prosecution of the instant application and without admission that any amendment is necessary, the Applicants have amended claim 1 to recite, among other things, an integral plastic and metal part comprising: (1) a metal component having a first opening therein; and (2) a plastic component disposed about at least a portion of said metal component, said plastic component being comprised of a plastic material, said plastic material extending through said first opening and including a flange on one side thereof for securing said plastic component with said metal component in fixed relationship therebetween, wherein said plastic component includes at least one integrally formed connection member extending outwardly therefrom, said at least one connection member having an area defining at least one connection portion formed therein, wherein said at least one connection portion is operable to receive a fastening member so as to permit said plastic component to be fastened to at least one other component, wherein at least a portion of said plastic component extends about and envelopes an external surface of said metal component.

No such structure, as recited in claim 1, is taught by Cunningham.

Specifically, Cunningham fails to teach or suggest, among other things, that at least a portion of the plastic component extends about and envelopes an external surface of the metal component.

Accordingly, the Applicants submit that the 35 USC §102(e) rejection of claim 1 has been overcome. Furthermore, claims 2-5, 9-11 and 13, which depend from and which further define independent claim 1, are likewise not anticipated by Cunningham. Therefore, the Applicants submit that the 35 USC §102(e) rejection of claims 1-5, 9-11 and 13 has been overcome.

35 USC §103(a) REJECTION

Claims 6-8 and 22-33 are rejected under 35 USC §103(a) as being unpatentable over Cunningham in view of U.S. Patent No. 5,219,197 to Rich et al.

The Applicants respectfully traverse the 35 USC §103(a) rejection of claims 6-8 and 22-33.

The standard for obviousness is that there must be some suggestion, either in the reference or in the relevant art, of how to modify what is disclosed to arrive at the claimed invention. In addition, "[s]omething in the prior art as a whole must suggest the desirability and, thus, the obviousness, of making" the modification to the art suggested by the Examiner. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 U.S.P.Q.2d 1434, 1438 (Fed.Cir.1988), cert. denied, 488 U.S. 825 (1988). Although the Examiner may suggest the teachings of a primary reference could be modified to arrive at the claimed subject matter, the modification is not obvious unless the prior art also suggests the desirability of such modification. *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed.Cir.1989). There must be a teaching in the prior art for the proposed combination or modification to be proper. *In re Newell*, 891 F.2d 899, 13 U.S.P.Q.2d 1248 (Fed.Cir.1989). If the prior art fails to provide this necessary teaching, suggestion, or incentive supporting the Examiner's suggested modification, the rejection based upon this suggested modification is in error and must be reversed. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed.Cir.1990).

Claims 6-8, which depend from and which further define independent claim 1, are not rendered obvious by Cunningham and/or Rich et al., either alone or in combination therewith for the reasons set forth above.

As noted in the Office Action, Cunningham fails to teach or suggest a metal component having a closed cross section and having a first opening therebetween from the interior to the exterior.

The recitation of Rich et al. does not cure the deficiencies in the teachings of Cunningham. Rich et al. arguably discloses the use of a closed cross section bar as asserted by the Examiner. Rich et al., however, requires the use of mechanical fasteners to seal the closed cross section metal component with a plastic component. This is the prior art of the type described in the background section of the application. Nothing in Rich et al. teaches or suggest an integral plastic and metal part, as recited in claims 6 and 22.

Cunningham fails to teach the use of a closed cross section metal component. Indeed, Cunningham discloses an oil pan made of plastic that may be secured to a support shell. The support shell may comprise metal or plastic. However, nowhere does Cunningham teach the closed metal cross section.

Nothing in Rich et al. teaches or suggests any combination where the closed cross section metal piece can be connected to a plastic piece other than by the use of mechanical fasteners. Similarly, nothing in Cunningham suggests its combination with a closed cross section metal piece. Notwithstanding that Cunningham states the support structure may have many shapes, none of this suggests a closed cross section. Indeed, if the metal support shell 14 were modified to comprise a closed cross section, it is not clear how the ribs 17 could then be formed therein.

No such structure, as recited in claim 22, is taught by Cunningham and/or Rich et al., either alone or in combination. It appears that the combination set forth in the Office Action can only be achieved by improper hindsight. The references appear to be chosen to show certain individual features and modified to achieve the claimed invention even though there is no suggestion for the modification.

Accordingly, the Applicants submit that Cunningham and/or Rich et al., either alone or in combination therewith, do not render claim 22 obvious. Furthermore, claims 23-33, which depend from and which further define independent claim 22, are likewise not rendered obvious by Cunningham and/or Rich et al., either alone or in combination therewith.

CONCLUSION

In view of the foregoing, the Applicants respectfully request reconsideration and reexamination of the Application. The Applicants respectfully submit that each item raised by the Examiner in the Office Action of October 18, 2005 has been successfully traversed, overcome, or rendered moot by this response. The Applicants respectfully submit that each of the claims in this Application is in condition for allowance and such allowance is earnestly solicited.

The Examiner is invited to telephone the Applicant's undersigned attorney at (248) 364-4300 if any unresolved matters remain.

Any needed extension of time is hereby requested with the filing of this document.

The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1612 (Warn Hoffmann Miller & LaLone). A duplicate copy of this letter is enclosed herewith.

Respectfully submitted,

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